

## **REMARKS**

### **I. Introduction**

With the addition of new claims 23 to 26, claims 1 to 26 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that the present application is in condition for allowance, and reconsideration is respectfully requested.

Applicant thanks the Examiner for considering the previously filed Information Disclosure Statement, PTO 1449 paper and cited references.

### **II. Rejection of Claims 3, 5 and 7 to 10 Under 35 U.S.C. § 112, First Paragraph**

Claims 3, 5 and 7 to 10 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. It is respectfully submitted that the present rejection should be withdrawn for at least the following reasons.

As an initial matter, reference to the paragraph added by the Preliminary Amendment filed on January 14, 2004 is not understood.

As another initial matter, claims 3, 5 and 7 to 10 are among the original claims of the present application. There is a strong presumption that an adequate written description of the claimed subject matter is present when the application is filed. *In re Wertheim* 541 F.2d 257, 263, 191 U.S.P.Q. 90, 97 (C.C.P.A. 1976) (“we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims”). As such, it is respectfully submitted that claims 3, 5 and 7 to 10 are supported by an adequate written description.

Furthermore, as regards claims 3 and 5, the Examiner’s attention is respectfully directed, for example, to page 2, lines 15 to 16 of the Specification.

As regards claims 7 to 10, the Examiner’s attention is respectfully directed, for example, to page 2, lines 17 to 20 of the Specification.

Therefore, in view of the foregoing, it is readily apparent that Applicant has possession of the subject matter claimed in claims 3, 5 and 7 to 10 at the time the present application was filed. Accordingly, withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims 1 and 20 to 22 Under 35 U.S.C. § 102(e)**

Claims 1 and 20-22 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2003/0234769 (“Cross et al.”). It is respectfully

submitted that Cross et al. do not render unpatentable the present claims for at least the following reasons.

Claim 1 relates to a display device and recites, in relevant part, that an actuator layer arranged on the display includes an operating surface geometry deformable as a function of a control signal. As described, for example, throughout the Specification, an operating surface geometry is deformed by a control signal to provide haptic feedback to the user, and operating elements may be tactically simulated by deforming the operating surface geometry by an appropriate control signal.

In stark contrast to the foregoing, Cross et al. describe, e.g., at paragraph [0070] a data processing system 800 with a transparent touch screen 806 arranged above a display 808. Even though the transparent touch screen 806 may be deformable when touched by a user or due to a touch force, Cross et al. in no manner disclose, or even suggest, that the transparent touch screen 806 is deformable as a function of a control signal. Figure 1B of Cross et al. depicts the layer 110 deforming as a result of being physically touched with sufficient force. A physical touch as described in Cross et al., paragraph [0034] is not a control signal.

Claims 20 to 22 include features similar to feature included in claim 1 that are not disclosed, or even suggested, by Cross et al.

Since Cross et al. do not disclose, or even suggest, all of the features recited in claims 1 and 20 to 22, it is respectfully submitted that Cross et al. do not anticipate claims 1 and 20 to 22.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

#### **IV. Rejection of Claims 1, 2, 4 to 6, 11 to 13 and 16 to 22 Under 35 U.S.C. § 103(a)**

Claims 1, 2, 4 to 6, 11 to 13 and 16 to 22 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,373,472 (“Palalau et al.”) and Cross et al. It is respectfully submitted that the combination of Palalau et al. and Cross et al. does not render unpatentable the present claims for at least the following reasons.

As more fully set forth above, Cross et al. do not disclose, or even suggest, an actuator layer that includes an operating surface geometry that is deformable as a function of a control signal. At page 4, the Office Action admits that Palalau et al. do not disclose this feature. Thus, since the combination of Cross et al. and Palalau et al. does not disclose, or even suggest, all of the features recited in claims 1 and 20 to 22, it is respectfully submitted

that the combination of Palalau et al. and Cross et al. does not render unpatentable claims 1 and 20 to 22.

As for claims 2, 4 to 6, 11 to 13 and 16 to 19, which ultimately depend from claim 1 and therefore include all of the features recited in claim 1, it is respectfully submitted that the combination of and Palalau et al. and Cross et al. does not render unpatentable these dependent claims for at least the same reasons more fully set forth above in support of the patentability of claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claims 7 to 10 Under 35 U.S.C. § 103(a)**

Claims 7 to 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Palalau et al., Cross et al. and U.S. Patent No. 5,252,951 (“Tannenbaum et al.”). It is respectfully submitted that the combination of Palalau et al., Cross et al. and Tannenbaum et al. does not render unpatentable the present claims for at least the following reasons.

Claims 7 to 10 depend from claim 1 and therefore include all of the features recited in claim 1. As more fully set forth above, the combination of Palalau et al. and Cross et al. does not render unpatentable claim 1, from which claims 7 to 10 depend. Tannenbaum et al. do not cure the critical deficiencies set forth above. As such, it is respectfully submitted that the combination of Palalau et al., Cross et al. and Tannenbaum et al. does not render unpatentable claims 7 to 10, which depend from claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VI. Rejection of Claims 14 Under 35 U.S.C. § 103(a)**

Claim 14 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Palalau et al., Cross et al. and U.S. Patent Application Publication No. 2004/0017362 (“Mulligan et al.”). It is respectfully submitted that the combination of Palalau et al., Cross et al. and Mulligan et al. does not render unpatentable present claim 14 for at least the following reasons.

Claim 14 depends from claim 1 and therefore include all of the features recited in claim 1. As more fully set forth above, the combination of Palalau et al. and Cross et al. does not render unpatentable claim 1, from which claim 14 depends. Mulligan et al. do not

cure the critical deficiencies set forth above. As such, it is respectfully submitted that the combination of Palalau et al., Cross et al. and Mulligan et al. does not render unpatentable claim 14, which depends from claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VII. Rejection of Claim 15 Under 35 U.S.C. § 103(a)**

Claim 15 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Palalau et al., Cross et al. and U.S. Patent No. 6,429,846 ("Rosenberg et al."). It is respectfully submitted that the combination of Palalau et al., Cross et al. and Rosenberg et al. does not render unpatentable claim 15 for at least the following reasons.

Claim 15 depends from claim 1 and therefore include all of the features recited in claim 1. As more fully set forth above, the combination of Palalau et al. and Cross et al. does not render unpatentable claim 1, from which claim 15 depends. Rosenberg et al. do not cure the critical deficiencies set forth above. As such, it is respectfully submitted that the combination of Palalau et al., Cross et al. and Rosenberg et al. does not render unpatentable claim 15, which depends from claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VIII. New Claims 23 to 26**

New claims 23 to 26 have been added herein. It is respectfully submitted that new claims 23 to 26 add no new matter and are fully supported by the present application, including the Specification. Since claims 23 to 26 depend from claim 1, it is respectfully submitted that claims 23 to 26 are patentable over the references relied upon for at least the same reasons more fully set forth above in support of the patentability of claim 1.

**IX. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

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Respectfully submitted,

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